

**REMARKS**

After entry of the present amendments, claims 1, 4, 6, and 9 remain in the application, with claims 1 and 6 in independent form. By the present Amendment, claims 1 and 6 have been amended. Also through the present Amendment, claims 7 and 8 have been cancelled. Claims 2-3 and 5 were previously cancelled. No new matter has been added.

Claims 1, 4, and 6-9 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor regards as the invention. These rejections all relate to the manner in which an  $\alpha,\beta$ -unsaturated polyester diol is claimed therein. Through the present Amendment, all references to the previously claimed  $\alpha,\beta$ -unsaturated polyester diol have been removed from the claims. As such, the Applicants respectfully assert that these rejections are now moot in view of the present Amendment, and respectfully request that these rejections be withdrawn.

Claims 1, 4, and 6-9 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,031,013 to Scherzer et al. In view of the cancellation of claims 7 and 8, the rejections now apply only to claims 1, 4, 6, and 9. The Examiner has argued that Scherzer et al. discloses the preparation of polyurethane foams from isocyanates, polyols, blowing agents, catalysts and other additives in the presence of a polyester polyol having make-up values meeting those of the polyester diol compounds as defined by the present claims. To further clarify, the Applicants note that the “polyester diol compounds” referred to by the Examiner are the  $\alpha,\beta$ -unsaturated polyester diols claimed in Markush format with other suitable compounds for compound (i) in the claims.

The Applicants respectfully assert that in view of the present Amendment, the rejections under 35 U.S.C. §102(e) are moot. More specifically, through the present

Amendment, all references to the  $\alpha,\beta$ -unsaturated polyester diol have been removed from the list of suitable compounds for compound (i) in the claims. Scherzer et al. does not disclose, teach, or suggest the remaining compounds claimed for compound (i) in the claims. As such, the Applicants respectfully request that the rejections of the claims under 35 U.S.C. §102(e) over Scherzer et al. be withdrawn.

In anticipation of possible rejections of the claims under 35 U.S.C. §103 over Scherzer et al., the Applicants respectfully note that “[t]he mere fact that components are claimed as members of a Markush group cannot be relied upon to establish the equivalency of these components.” See MPEP 2144.06 citing *In re Scott*, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963). Further, the Applicants note that “the equivalency must be recognized in the prior art, and cannot be based on applicant’s disclosure or the mere fact that the components at issue are functional or mechanical equivalents.” See MPEP 2144.06 citing *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

The Applicants respectfully assert that  $\alpha,\beta$ -unsaturated polyester diol and the remaining compounds claimed as suitable for compound (i) in the present claims are **not** recognized as equivalents by either Scherzer et al. or the prior art in general, and the Applicants have not conceded such art-recognized equivalency.

Scherzer et al. makes it clear that the disclosed polyester diol is an integral reactant in the production of the foam itself, as a so-called “compound which [is] reactive toward isocyanates”. The polyester diol is a member of a group of the compounds which are reactive toward isocyanates that includes polyols such as polyetherpolyamines, polyether polyols, polythioether polyols, polyesteramides, etc. In essence, the polyester diol disclosed by Scherzer et al. is recognized by Scherzer et al. to be equivalent to other polyols. While

Scherzer et al. discloses that, if desired, chain extenders and/or crosslinkers may be used, it is clear that the “compound which is reactive toward isocyanates” is the main reactant that reacts with the isocyanate to form polyurethane. Scherzer et al. further recognizes no link whatsoever between the disclosed polyester diol and reduced discoloration in the resulting foam.

Because many of the compounds claimed as suitable for compound (i) in the present claims have only a single isocyanate-reactive group, such compounds are neither recognized as equivalents nor would they be suitable for the use in which the polyester diols are employed in Scherzer et al. The polyester diol disclosed in Scherzer et al. is merely present as a reactant for forming polyurethane by reaction with the isocyanate and, as set forth above, Scherzer et al. recognizes no link between the polyester diol and reduced discoloration of the resulting foam. For this reason, it is clear that Scherzer et al. does not recognize the polyester diols as an equivalent to the rest of the compounds claimed as suitable for compound (i) in the present claims. Further, the prior art, in general, does not recognize an equivalence between  $\alpha,\beta$ -unsaturated polyester diol and the rest of the compounds claimed as suitable for compound (i) in the present claims.

In view of the foregoing, the Applicants respectfully assert that the present claims, as amended, are both novel and non-obvious in view of the prior art relied upon by the Examiner. As such, the Applicants respectfully submit that the claims, as amended, are now in condition for allowance and respectfully request such allowance.

This Amendment is being filed timely, as such it is believed that no fees are presently due. However, the Commissioner is authorized to charge the Deposit Account No. 08-2789, in the name of Howard & Howard Attorneys, P.C., for any fees or credit the account for any overpayment.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS**

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Date

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